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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,461

07/17/2003

Takeshi Misawa

0649-0901P

9184

2292

7590

12/14/2004

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EXAMINER

MAGEE, THOMAS J

ART UNIT

PAPER NUMBER

2811

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/620,461

Applicant(s)

MISAWA, TAKESHI

Examiner

Thomas J. Magee

Art Unit

2811

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: (See attached sheet).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

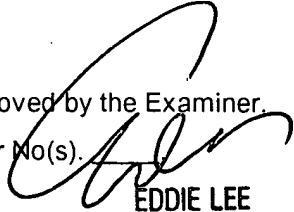
Claim(s) rejected: 1-10

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).

10. ☐ Other: \_\_\_\_\_

  
EDDIE LEE  
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Item 5c):

Arguments of Applicant in regard to claim rejections have been carefully considered, but these have been found to be unpersuasive. With regard to the contention by Applicant that Strnad does not render a surface for light-shading or reflecting (scattering) light (pp. 3 –4, Response) Examiner does not agree. The reference states (Col. 2, lines 5 – 10) that the effect of backsurface polishing (grinding) is the “creation of a rough backside surface (24) that includes a plurality of peaks (26) and valleys (28)” that can “scatter radiation (photons) being emitted from the IC.” Hence, the reference teaches that mechanical polishing produces a backsurface that scatters (reflects) light and is therefore usable for “light shading.” Further, the disclosure of Strnad is consistent with the Specification of the instant application, wherein it is stated (p. 3, lines 12 – 13) that *“the light shading means may be formed by making rough the area,”* and (p. 5, lines 4 – 8) *“by also making unevenness such as by grinding the rear surface of the solid-state image pickup device, it is possible to suppress the influence of light reflected from the rear surface....”* Therefore, the combination of Strnad and Malinovich et al. can be used to provide light shading, and the combined references do read on the claim.

In regard to commentary on the rejection for Claim 9 (pp. 6 – 7), Examiner again disagrees with the contention that the two references cannot be combined. As discussed above, the two references are combined to provide a “light shading” mechanism and more than sufficient motivation for combining exists. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*,

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800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Rather, the real test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

With regard to contentions by Applicant for Claim 10 (pp. 8 – 9, Response) that the references are not combinable, Applicant is in error. It is the light shading adhesive of Fjelstad that is used in the combination. The claim does not dictate the wavelength transmissive/scattering properties of the resin layer and simply states, a “*light shading adhesive, the light shading suppressing light reflected from the rear surface..*” As such, the resin of Fjelstad is “opaque” (Col. 7, line 44) according to wavelength and suppresses light reflected (scattered) from the rear surface.

Further, the Specification of the instant application states that “an epoxy resin may be applied to the rear surface,” but does not specify wavelength of the light. Hence, the combination of the resin of Fjelstad and the optical device of Malinovich et al. read on the claim.

In light of the above, the rejection is maintained.